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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,752	02/02/2001	Takashi Yamaguchi	0649-0772P	6901

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EXAMINER
YOON, TAE H

ART UNIT	PAPER NUMBER
1714	14

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-14

Office Action Summary

Application No.	Applicant(s)
09/773,752	Yamaguchi et al
Examiner	**Group Art Unit**
T. Yoon	1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 10-15-02.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 11

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,300,387 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the unsaturated polyester and unsaturated polyester-polyamide of said patent encompass the instant unsaturated polyester and unsaturated polyester-polyamide as evidenced by the teaching at col. 2, lines 16-27 and the iodine values in examples.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The recited softening point regarding the molding composition does not have support in the specification, and thus constitutes New Matter. Contrary to applicant's statment, the teaching on page 7, lines 4-5 is diected to the Component (C), not to the molding composition.

Claims 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims are non-enabling since the crosslinked product (solid molding composition) can not have a softening point, and applicant failed to show otherwise.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "wherein the composition is substantially free of ethylenicaly unsaturated group-containing monomers" is indefinite since there is no definition with respect to said "substantially free of". For example, is it 3% or 10 %?

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hefner, Jr. et al (US 4,524,178) in view of JP 63-305160.

Rejection is maintained for reason of record and following.

With respect to applicant's argument regarding the molding composition and the matted molded articles, the intended use has no probative value. Also, applicant's argument that the materials as disclosed in Hefner and JP'160 can not be used for the products made by the instant invention has little probative value since the claims are directed to a composition, not to a matted product.

Applicant's argument on page 8 of the response based on the different components for the art of resinous molded articles and the art of matted materials has little probative value since the instantly recited aggregate encompasses a reinforcement material absent particular fibrous substrates. In fact, Hefner, Jr. et al teach the use of reinforcing fibers is taught at col. 7, line 29.

Also, note the claim 1 of Hefner, Jr. et al wherein 0 parts by weight of an ethylenicaly unsaturated group-containing (vinyl) monomer is taught. Thus, said 0 parts by weight or 1 to 10 parts by weight, for example, meets the instant "substantially free of ethylenicaly unsaturated group-containing monomers".

Contrary to applicant's assertion, Hefner, Jr. et al teach sheet molding compounds at col. 7, line 52 would meet the instant construction insulators, for example, even though said construction insulators have no probative value.

Note that a reaction of 2 mol of alkylene oxide and 1 mol of bisphenol A would yield 1 mol of bis(hydroypropyl)bisphenol A.

The instant claim 8 reciting 3-50 mol% of the bisphenol A adduct encompasses the comparative example 1. Also, the claims 1 and 9 reciting 3-40 mol% of the bisphenol A adduct are broader than the examples wherein 3.3 to 19.8 mol% are used, thus the argument based on the unexpected results has little probative value.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al (US 5,077,326) or Wiseman (US 5,741,448) alone, or in view of JP 63-305160.

Shibata et al teach unsaturated polyester resin compositions containing glass fibers and peroxide in table 1. Said unsaturated polyester can be made from an adduct of bisphenol A and ethylene or propylene oxide (col. 2, lines 45-47). Wiseman teaches the same at col. 3, lines 4-6 including hydrogenated bisphenol A), col. 4, lines 11-17 and in claims. The instantly recited properties are inherently present since all compositions are used in the same purpose, and applicant failed to show otherwise.

The instant invention further recites 3 to 40 (or 50) mol% of said adduct over Shibata et al and Wiseman. JP teaches an unsaturated polyester having at least 1/6 mol (about 16.7 mol%) of hydrogenated bisphenol A glycol in abstract.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the instantly claimed amount of an adduct in obtaining an unsaturated polyester of Shibata et al or Wiseman with or without teaching of JP since choosing a species within the disclosure is a *prima facie* obviousness and since the use of the instantly claimed amount of an adduct is well known as taught by JP absent showing otherwise.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/December 16, 2002

TAE H. YOON
PRIMARY EXAMINER